



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/636,164	08/06/2003	Robert A. Kerr II	13357.4002	3599

34313 7590 10/28/2004

ORRICK, HERRINGTON & SUTCLIFFE, LLP
4 PARK PLAZA
SUITE 1600
IRVINE, CA 92614-2558

EXAMINER

JEFFERY, JOHN A

ART UNIT PAPER NUMBER

3742

DATE MAILED: 10/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/636,164

Applicant(s)

KERR, ROBERT A.

Examiner

John A. Jeffery

Art Unit

3742

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) 11-20, 32-38, 40 and 41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4-10, 21-24, 27-31, 39 and 42 is/are rejected.
- 7) ☒ Claim(s) 2, 3, 25 and 26 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>20040806</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgement of Elected Claims Without Traverse

Applicant's election of Species A and Subspecies 1 without traverse is acknowledged. The examiner, however, respectfully disagrees with applicant's listing of claims readable on the elected species. Although applicant asserts that claims 18-23 read on the elected species, the examiner notes that claims 18-20 -- directed to diverse types of communications systems -- do not read on the elected species. Moreover, in contrast to applicant's assertion that claims 39-42 read on the elected species, the examiner maintains that claims 40 and 41 (computer system and cell phone transmission steps) do not read on the elected species.

Accordingly, claims 11-20, 32-38, 40, and 41 are withdrawn from consideration as being directed to nonelected species.

Disclosure Objections

The disclosure is objected to because of the following informalities:

The use of the trademark "Bluetooth" has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks. For

example, claim 19 contains the trademark/trade name "Bluetooth." Applicant is advised that where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). Furthermore, the claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Appropriate correction is required.

Claim Rejections - 35 U.S.C. § 103(a)

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 1, 4-10, 21-24, 27-31, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO98/59487 in view of Peifer et al (US5987519). WO98/59487 discloses a "measuring device" 10 for measuring physiological attributes, "integration device" (adaptor 400 and computer 30) and a "communications device" within the computer that enables transmission of the measurement data over the internet after conversion into ASCII characters (i.e., a text string). Received data can be

Art Unit: 3742

stored in a database. See Page 6, lines 14-16 and Page 8, lines 25-26. According to P. 8, lines 3-4, a unique device identification code is provided in addition to the measurement data. Regarding claim 10, according to Page 4, line 22, the measuring device can directly serve a scale.

The claims differ from WO98/59487 in calling for (1) the measuring device to comprise a digital display, and (2) for the conversion step to add a unique identifier for both the user and the device itself. Although WO98/59487 on Page 8, lines 3-4 teaches providing a unique identifier for the measurement device, there is no unique identifier for the patient using the device as well. However, Peifer et al (US5987519) in col. 8, lines 43-60 teaches providing unique identifiers for both the patient and the measurement device to the communications device. In view of Peifer et al (US5987519), it would have been obvious to one of ordinary skill in the art to provide unique identifiers for both the patient and the measurement device in conjunction with the previously described apparatus so that both the user and the measurement device are uniquely identified by the remote system, thereby associating received data with the device and patient thus facilitating automated database entry.

In addition, providing digital displays for measurement devices is conventional and well known in the art in order to provide instant visual feedback to the user of the sensed condition and their use does not constitute a patentably distinguishable feature of the invention. Regarding claim 23, web-based portals are well known user interfaces in the art to enable users access network-based resources from remote locations. Regarding claims 21 and 30, receipt messages sent from remote devices indicating

Art Unit: 3742

successful data receipt are conventional and well known in the art in order to confirm successful data transfer to the sender and do not constitute a patentably distinguishable feature of the invention.

Regarding claim 22, no criticality is seen in integrating the integration system with the communications system or measuring device in view of Applicant's admissions on Para. 0023 of the instant specification wherein it is stated that integration and communications systems can be distinct or integral.

Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO98/59487 in view of Peifer et al (US5987519) and further in view of Heinonen et al (US6421633). The claims differ from the previously cited prior art in calling for a two-way pager for wireless transmission of the second signal to the Internet. Providing a pager for wireless data transmission of medical measurement data is conventional and well known in the art as evidenced by Heinonen et al (US6421633) noting col. 7, lines 10-65 wherein a two-way pager is provided for wireless data transmission. See Fig. 6. In view of Heinonen et al (US6421633), it would have been obvious to one of ordinary skill in the art to provide a two-way pager in lieu of a hardwired link so that the data could be transferred wirelessly from any remote location thereby precluding the need for the user to be near telephone jacks or network connections.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 4-10, 21-24, 27-31, 39, and 42 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 6,612,984. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant application are merely broader in scope than the patented claims. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993). Moreover, there is no apparent reason why

Art Unit: 3742

applicant could not have presented the instant claims during prosecution of the '984 patent.

Allowable Subject Matter

Claims 2, 3, 25, and 26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John A. Jeffery whose telephone number is (703) 306-4601. The examiner can normally be reached on Monday - Thursday from 7:00 AM to 4:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robin Evans, can be reached on (703) 305-5766. All faxes should be sent to the centralized fax number at (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

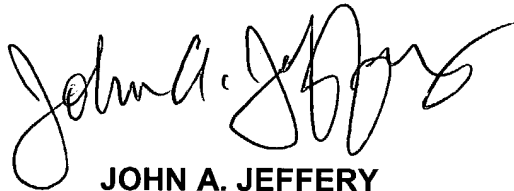
Application/Control Number: 10/636,164

Page 8

Art Unit: 3742

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free)

A handwritten signature in black ink, appearing to read "John A. Jeffery". The signature is stylized with a large, looping "J" and a cursive "Jeffery".

**JOHN A. JEFFERY
PRIMARY EXAMINER**

10/27/04